

REMARKS

Claims 1-15, 25, 26 and 53-56 are pending in the application. In view of the present substitute Declarations and the below remarks, reconsideration and allowance of this application is believed to be in order and the same is respectfully requested.

In the June 21, 2004, Action, after allowing claims 1-15, 25 and 26 with only requiring that formal matters be corrected, the Examiner rejected pending claims 1-4 and 6-15, 25, and 26, as either being anticipated or rendered obvious in view of Proksch et al., U.S. Publication 2004/0000189 (hereinafter "Proksch et al. publication").

In response to the Examiner's rejection, Applicant filed Declarations that the Examiner found non-persuasive in his February 24, 2005, Office Action for not setting forth where the inventive work was done. In response, Applicant has attached hereto Declarations under 37 CFR § 1.131 of Jens Struckmeier, Doug Gotthard, and Benjamin Ohler, the inventors of the above-identified application (which may be referred to herein as "Inventor Declarations"), that more specifically state that the inventive work was performed in the United States at Veeco Instruments, Inc. ("Veeco"), the present assignee, in Santa Barbara, California.

In these Declarations, the inventors state that conception and assembly of an apparatus (reduction to practice), as that described and claimed in the above-identified application, occurred at Veeco prior to the effective filing date of the Proksch et al. publication, November 5, 2001. (Ohler Declaration, ¶3; Struckmeier Declaration, ¶3; Gotthard Declaration, ¶3).

In support of their Declarations, Mssrs. Ohler, Struckmeier and Gotthard provide true and correct copies of e-mails and engineering notebook pages prepared by Mr. Ohler illustrating the development of the SPM force-measurement system of the present invention at Veeco. More particularly, a schematic block diagram of the force measurement circuit in accordance with the preferred embodiments is shown in Exhibit B. The first page of Exhibit B is labeled "Puller Knob" which is a direct reference to manual control when doing force measurements using, for instance, an atomic force microscope (AFM). (Exhibit B) The schematic not only refers to the

knob (i.e., “manual input device”), but the alerting device as well (e.g., passive resistance device, identified as “magnetic particle brake”). (Inventor Declarations, ¶6, citing Exhibit B) These pages were completed, and the apparatus built, prior to November 5, 2001, the effective filing date of the Proksch et al. publication. (Inventor Declarations, ¶5) Similarly, among other things, the second page of Exhibit B refers to “Knob box Required Lines” and identifies the “brake” input. All of this work was completed at Veeco.

Further support of the inventor’s activities relating to the claimed subject matter is provided in Exhibit A which sets forth Mr. Ohler’s e-mail to Mr. Gotthard outlining the general scheme of an assembly designed for the manual control of force measurements, including identifying the “knob” and the “brake”. The other e-mails authored by Mr. Ohler identify similar components, as well as their expected delivery dates. (Exhibit A, pp. 2 & 3) These e-mails were substantially sent and received at Veeco.

According to the inventors, the system identified in Exhibits A and B was designed, assembled and operated at Veeco prior to the effective date of Proksch et al. In other words, the inventors actually built the described apparatus at Veeco in the United States, and operated the apparatus such that it worked for its intended purpose.

In view of the foregoing Remarks and attached substitute Declarations, it is believed that Applicant has established invention of the subject matter of claims of the pending application in the United States, at Veeco, prior to the effective filing date of the Proksch et al. publication. Applicant therefore believes that the Proksch et al. publication is not prior art with respect to the present application and withdrawal of the Examiner’s rejections of the pending claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) is respectfully requested. As a result, claims 1-15, 25 and 26, should be allowed, as they were in the Examiner’s January 13, 2004, Office Action. Such action is earnestly solicited.

In addition, to reiterate with respect to claims 53-56 added in Applicant’s November 22, 2004, Reply, these claims define similar limitations to those of the above-discussed claims. In

Serial No. 10/006,090 to Struckmeier et al.

Art Unit: 2856

Page 8

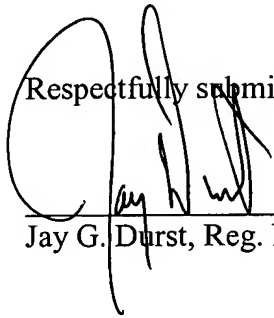
particular, new independent claim 53 defines a manual input device and a brake, while claim 54 defines a manual input device and a braking means (no scanner limitation in either). Claims 55 and 56 are dependent from allowable independent claim 25 and define the alerting device as a passive resistance device (55) which can be a brake (56).

Given that these claims include structure not disclosed in the cited prior art, including a manual input device and a mechanical resistance device (e.g., a brake), claims 53-56 are likewise allowable. An indication to that effect is respectfully requested.

Should the Examiner have any questions or comments that could expedite the completion of prosecution of this case, he is invited to contact the undersigned at the number below.

No fees are believed to be due in connection with this Reply. Nonetheless, the Director is authorized to direct any additional fees associated with this or any other communication, or credit any overpayment, to Deposit Account 50-1170.

Respectfully submitted,


Jay G. Durst, Reg. No. 41,723

Dated: **May 24, 2005**
BOYLE, FREDRICKSON, NEWHOLM,
STEIN & GRATZ S.C.
250 Plaza, Suite 1030
250 East Wisconsin Avenue
Milwaukee, WI 53202
Telephone: (414) 225-9755
Facsimile: (414) 225-9753